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EXAMINER

BUTLER, PATRICK NEAL

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Declaration***

As indicated in Box 10, the declaration under 37 CFR 1.132 filed 29 October 2008 is entered. It is insufficient to overcome the rejection of claims 18-22, 24-39, 41, 43, and 45-55 under 35 U.S.C. § 112, first paragraph, and based upon the references applied under 35 U.S.C. § 103 as set forth in the last Office Action mailed 29 April 2008. The status of the claims is as follows: Claims rejected: 18-22, 24-39, 41, 43, and 45-55.

Indications of the declaration under 37 CFR 1.132 filed 29 October 2008 appear to be on the grounds that:

1) The Specification as originally filed teaches fracturing of the panel and ejection of plugs at an intermediate depth. A panel must be cured for this to happen. Thus, curing before punching is disclosed.

2) As indicated in the figures of the Specification as originally filed, manipulation of the panel does not require support in Figure 5. A panel must be cured for this to happen. Thus, curing before punching is disclosed.

The indications of the Affidavit are addressed as follows:

1 and 2) Since the Declaration does not contain an indication of an event, act, or occurrence that has actually taken place, the Declaration, in general, is accorded opinion evidence status as it is, at best, a statement expressing what the person making it thinks, believes, or infers with regard to certain facts. Appropriate weight is given to the opinion evidence. However, no factual evidence has been made of record showing lack of fracture and lack of plug ejection of panels at different levels of being cured or

uncured. The absence of factual support for the opinion makes it difficult to accord the opinion significant weight in overcoming the rejection.

2) Figure 5's lack of support does not provide support for the claimed negative limitation; the mere absence of a positive recitation is not basis for exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. See MPEP § 2713.05(i).

2) Moreover, Figure 5 may not be relied upon to show distances between supports. When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See MPEP § 2125.

2) Figure 5 is interpreted by the Examiner to be representative of Applicant's process but not necessarily including every element present in the process. Thus, missing elements, such as support structures, may simply not be shown rather than excluded.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

### ***Response to Arguments***

Applicant's arguments filed 29 October 2008 have been fully considered but they are not persuasive.

Applicant argues with respect to the 35 U.S.C. § 112, first paragraph, rejections. Applicant's arguments appear to be on the grounds that:

1) The claim term "cured" is clarified by a declaration submitted 28 October 2008 as necessitated by Applicant's previous understanding that "cured" met the requirements of 35 U.S.C. § 112, first paragraph.

The Applicant's arguments are addressed as follows:

1) The Examiner's Interview Summary includes the substance of the interview on 24 January 2008. Clarification of Applicant's Interview was provided as recited on page 2 of the Office Action mailed 29 April 2008:

Regarding the Interview 24 January 2008, Applicant's Interview Summary, submitted 28 January 2008, is contrary to the Interview Summary provided by the Examiner. Applicant's Specification's support for curing was discussed.

However, agreement was not reached regarding the claimed order of curing before punching.

1) Discussion of existence of the claim term in Applicant's Specification is moot since the claimed order, rather than simply presence, of curing in Applicant's process is grounds for the 35 U.S.C. § 112, first paragraph, rejections as recited on page 2 of the Office Action mailed 29 April 2008:

In Claim 19, line 3; Claim 25, line 3; Claim 31, line 3; Claim 38, line 3; Claim 42, line 2; and Claim 49, line 2 require that a "cured" fiber-cement panel be punched. Applicant's Specification discusses known methods of punching fiber-cement panels to include curing the panels (see Specification, Background section, [0002]) without providing support for curing of the panels manipulated by Applicant's invention. Thus, neither pre-punching nor post-punching curing is

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clarified with respect to Applicant's invention. Claims 18, 20-22, 24, 26-30, 32-37, 39, 41, 43, 45-48, and 50-55 are rejected via their dependency.

1) The Arguments pertain to the declaration as addressed in the Declaration section above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Butler whose telephone number is (571) 272-8517. The examiner can normally be reached on Mon.-Thu. 7:30 a.m.-5 p.m. and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. B./  
Examiner, Art Unit 1791

/Christina Johnson/  
Supervisory Patent Examiner, Art Unit 1791